UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,978	08/31/2001	Ken Kutaragi	100809-16279 (SCEW 18.968	7677

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EXAMINER
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ART UNIT	PAPER NUMBER
2424	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/942,978	KUTARAGI ET AL.
	Examiner	Art Unit	
	MICHAEL VAN HANDEL	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _06 July 2009_.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-8_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-8_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 7/06/2009 has been entered.

Response to Amendment

2.   This action is responsive to an Amendment filed 7/06/2009. Claims **1-8** are pending.

Claims **1**, **2**, **4**, **6**, **7** are amended. Claims **9-12** are canceled.

Response to Arguments

3.   Applicant's arguments regarding claims **1**, **2**, **4**, **6**, and **7**, filed 7/06/2009, have been fully

considered, but they are not persuasive.

        Regarding claims **1**, **2**, **4**, **6**, and **7**, the applicant argues that Stefik et al. is silent on any

selectivity between encryption and/or compression of content and encryption and/or compression

of usage right information. The examiner respectfully disagrees. Stefik et al. discloses a fee

accounting system where creators create digital works and determine appropriate usage rights

and fees, which they permanently attach to the digital work (col. 6, l. 50-51 & col. 7, l. 7-10).

Other creators and distributors utilize this work in combination with other works to create

composite works (col. 6, l. 40-42). The structure of these digital works is organized as a

hierarchy of nodes of works (col. 9, l. 8-13). Usage rights are placed on each node by its creator,

so that the creator of a work can be assured that the rights and fees are not circumvented (col. 9,

l. 16-20). Figures 5 and 6 illustrate the hierarchy of a composite digital work (col. 9, l. 50-52 &

Figs. 5, 6). The description tree for a digital work is comprised of a set of related descriptor

blocks (d-blocks), each of which specifies the granted usage rights of its corresponding node

(col. 9, l. 50-67). A special type of d-block is a "shell" d-block. A shell d-block adds no new

content beyond the content of its parts and is used to add rights and fee information, typically by

distributors of digital works (col. 10, l. 8-11 & Figs. 8, 9). For example, in an Embed

transaction, a creator or distributor makes a digital work become a part of another digital work or

adds a shell d-block to enable the adding of fees by a distributor of the work. The rights of the

original work and all of its parts are updated and transmitted to the requestor (col. 11, l. 58-67;

col. 12, l. 1-40; col. 41, l. 53-67; & col. 42, l. 1-15). Stefik et al. further discloses compressing or

encrypting the data in the contents file (col. 9, l. 47-49).

As noted by the applicant, the examiner interprets a "d-block" to be attribute data that is

added to the encrypted archive data, as currently claimed. In response to applicant's argument

that the references fail to show certain features of applicant's invention, it is noted that the

features upon which applicant relies (i.e., providing for attribute data than can be read without

any decryption or decompression) are not recited in the rejected claim(s). Although the claims

are interpreted in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner

also notes that Stefik et al. discloses adding a "shell" d-block, that adds no new content beyond

the content of its parts and adds only rights and fee information (col. 10, l. 8-11). Stefik et al.

also discloses that the d-blocks of the description tree file make it possible to examine the rights

and fees for a work without reference to the content of the digital work (col. 9, l. 27-30). Since

this portion is not part of the content itself, and Stefik et al. only discloses compressing or

encrypting the contents, it does not appear that decryption or decompression would be needed to

read the digital rights information of the d-block. As such, the examiner maintains that Stefik et

al. meets the limitation of selectively encrypting said archive data and adding an attribute data to

the encrypted archive data, as currently claimed.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims **1**, **6** are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al.

Referring to claims **1** and **6**, Stefik et al. discloses a method/system for managing fees of

contents in which the fees arise based on a predetermined charging rule upon distributing the

contents (col. 4, l. 4-10), said method/system comprising the steps of:

-       equipping information gathering means on a network (Billing Clearinghouse) with

which a user terminal (computer system) is allowed to connect (col. 7, l. 5-37), said

user terminal carrying out information processing by utilizing said contents (col. 7, l.

66-67; col. 8, l. 1-18, 57-67; col. 9, l. 1-5; & Figs. 3, 4b);

- embedding digital information (usage right and fees) to said contents (col. 7, l. 7-10; col. 10, l. 8-11; & col. 11, l. 44-52), said digital information itself including functionality provided to said user terminal to autonomously monitor, and store, a contents utilizing history at the user terminal (metering rights provide functionality to autonomously monitor the utilization of contents, because the clock in the credit server would not monitor the time usage of contents if metered usage rights were not set)(col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col. 26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and transmit the stored contents utilizing history along with identification information (col. 31, l. 16-18, 37-41) to said information gathering means at a predetermined timing while said user terminal is connected with said network (col. 8, l. 10-20, 57-67; col. 9, l. 1-5; col. 18, l. 12-45; & Fig. 3);

- processing a plurality of said contents, in each of which the digital information is embedded, to one archive data (composite work comprised of multiple digital works)(col. 6, l. 39-42; col. 10, l. 8-11; col. 11, l. 52-55; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- selectively encrypting said archive data and adding an attribute data to the encrypted archive data (contents can be encrypted for security and digital rights can be added by creator or distributor)(col. 9, l. 49; col. 10, l. 8-11; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- distributing said archive data and attribute data through a predetermined distribution mechanism (col. 11, l. 31-56; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);

- holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (the digital work state information and credit server keep track of how content rights have/are being used)(col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-45);

- counting a distribution condition of contents per distribution mechanism based on said contents utilizing history gathered through said information gathering means and said identification information held by said identification information holding means (Copies-in-Use field, History-list, weighted distribution fees dependent on number of copies, etc.)(col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; & Fig. 14); and

- determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents (credit server performs recording and reporting of fees associated with exercising rights)(col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col. 32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),

- wherein the contents utilizing history is stored permanently as long as the contents is utilized (keeps track of remaining time content can be used)(col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57).

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims **2-5**, **7**, and **8** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stefik et al. in view of Aras et al.

        Referring to claims **2**, **4**, and **7**, Stefik et al. discloses a method/system for managing fees

of contents in which the fees arise based on a predetermined charging rule upon utilizing the

contents (col. 4, l. 4-10), said method comprising the steps of:

-       issuing a recording medium to a user operating a user terminal which carries out

        information processing by utilizing said contents (repository is embedded in a "card"

        that is inserted into an available slot in a computer system and a single device can be

        both a repository and a credit server)(col. 17, l. 31-36 & col. 18, l. 24-38), said

        recording medium having a data recording area in which user identification data is

        recorded (col. 13, l. 51-54, 59-67) and a memory area (col. 14, l. 28-39);

-       equipping information gathering (Billing Clearinghouse) means on a network with

        which said user terminal with said recording medium being loaded is allowed to

        connect (col. 7, l. 5-37);

-       embedding digital information (usage rights and fees) to said contents, said digital

        information itself including functionality provided to said user terminal to

        autonomously monitor, and store to said memory area, a contents utilizing history

        indicating utilizing condition of the contents at the user terminal (metering rights

provide functionality to autonomously monitor the utilization of contents, because the clock in the credit server would not monitor the time usage of contents if metered usage rights were not set)(col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col. 26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network (col. 8, l. 10-20, 57-67; col. 9, l. 1-5; col. 18, l. 1-45; & Fig. 3);

- processing a plurality of said contents, in each of which the digital information is embedded, to one archive data (composite work comprised of multiple digital works)(col. 6, l. 39-42; col. 10, l. 8-11; col. 11, l. 52-55; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- selectively encrypting said archive data and adding an attribute data to the encrypted archive data (contents can be encrypted for security and digital rights can be added by creator or distributor)(col. 9, l. 49; col. 10, l. 8-11; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- distributing said archive data and attribute data through a predetermined distribution mechanism (col. 11, l. 31-56; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);

- holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (the digital work state information and credit server keep track of how content rights

have/are being used)(col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col.

18, l. 1-45);

- counting a utilization condition of the contents per user based on the contents

    utilizing history and the user identification data gathered through said information

    gathering means (Copies-in-Use field, History-list, weighted distribution fees

    dependent on number of copies, etc.)(col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 47,

    l. 30-45; & Fig. 14); and

- determining a charging amount per user based on said counted utilization condition

    and a charging rule for said contents (credit server performs recording and reporting

    of fees associated with exercising rights)(col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col.

    32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),

- wherein the contents utilizing history is stored permanently as long as the contents is

    utilized (keeps track of remaining time content can be used)(col. 10, l. 58-65; col. 14,

    l. 40-44; & col. 33, l. 53-57).

Stefik et al. does not specifically disclose that the memory area of the data recording area be a

nonvolatile memory area. Aras et al. discloses a method and apparatus for monitoring audio-

visual materials presented to a subscriber (col. 6, l. 32-52). Monitored audio-visual information

is stored in a Behavior Collection Table (BCT)(col. 9, l. 2-11). The BCT table is stored to a non-

volatile memory, such as a flash memory (col. 16, l. 46-49). The collected information is then

sent to a Behavior Collection Center (BCC) for processing (col. 12, l. 40-54). It would have

been obvious to one of ordinary skill in the art at the time that the invention was made to modify

the memory of Stefik et al. to be a non-volatile memory, such as that taught by Aras et al. in order to retain data in a power off event (Aras et al. col. 16, l. 34-49).

Referring to claims **3** and **5**, the combination of Stefik et al. and Aras et al. teaches a method for managing fees of contents according to claims 2 and 4, respectively, further comprising the steps of encrypting the contents to be distributed and issuing key information for decrypting said encrypted contents, said key information being recorded in said recording medium (Stefik et al. col. 28, l. 1-37).

Referring to claim **8**, the combination of Stefik et al. and Aras et al. teaches a system for managing fees of contents according to claim 7, wherein said recording medium is a card equipped with an IC chip (Stefik et al. col. 14, l. 7-50 & col. 17, l. 32-36), said card being individualized per user (Stefik et al. col. 13, l. 51-67), and information indispensable for utilizing said contents is recorded in said card (Stefik et al. col. 28, l. 28-30).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Van Handel/
Examiner, Art Unit 2424

8/10/2009